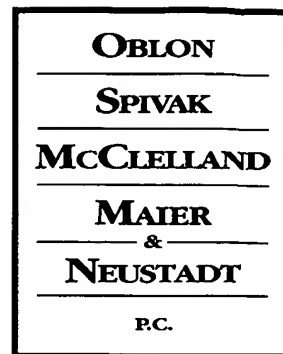




Docket No.: 244230US2S CONT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

RE: Application Serial No.: 10/690,644

Applicants: Katsuhiko YOSHIDA, et al.

Filing Date: October 23, 2003

For: COIL FOR ELECTRIC ROTATING MACHINE, AND
MICA TAPE AND MICA SHEET USED FOR THE
COIL INSULATION

Group Art Unit: 2831

Examiner: Chau N. NGUYEN

SIR:

Attached hereto for filing are the following papers:

Statement of the Substance of the Interview with Attachments (2)

Our credit card payment form in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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DOCKET NO: 244230US2S CONT



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
KATSUHIKO YOSHIDA, ET AL. : EXAMINER: CHAU N. NGUYEN
SERIAL NO: 10/690,644 :
FILED: OCTOBER 23, 2003 : GROUP ART UNIT: 2831
FOR: COIL FOR ELECTRIC ROTATING :
MACHINE, AND MICA TAPE AND MICA
SHEET USED FOR THE COIL
INSULATION

STATEMENT OF THE SUBSTANCE OF THE INTERVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

During the interview of May 17, 2005, the Response filed on May 6, 2005 was discussed. The Examiner acknowledged that the outstanding rejection of the claims was based on an argument that the recited glue was inherently soluble in resin. Applicants' representative noted that the Official Action provides no rationale for this finding of inherency. "The fact that a certain result may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic."¹

Attached to this document please find two documents that indicate that polyvinyl alcohol has a high degree of solubility in water and is characterized by solubility and liquid absorptivity in many liquids. However, these documents do not disclose or suggest that

¹ *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1995, 1957 (Fed. Cir. 1993).

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Statement of the Substance of the Interview

polyvinyl alcohol is soluble in resin. It is only through the inventors' experimentation was it discovered that polyvinyl alcohol could be dissolved in resin.

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'"² Because the Official Action provides no explanation of why Applicants' claimed features are inherent, Applicants submit the rejection is improper.³

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



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² *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

³ MPEP § 2112, IV "Examiner must provide rationale or evidence tending to show inherency."